

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VICTOR B. ROBINETT

Appeal No. 96-1639
Application 08/269,140¹

ON BRIEF

Before THOMAS, JERRY SMITH and CARMICHAEL, *Administrative Patent Judges*.

CARMICHAEL, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of Claims 1-13. The other remaining claims, Claims 14 and 15, have been indicated as directed to patentable subject matter.

Claim 1 reads as follows:

¹ Application for patent filed June 30, 1994.

1. A method for the in-place testing of the shear strength of a rectangular area of a wall, said wall having vertical and horizontal structural elements, said rectangular area having an upper, first-side corner and a lower, second-side corner, an upper side, a first side and an second side, and a lower side, said method comprising the steps of:

affixing a first shoe to the upper, first-side corner, said first shoe having a first strut-supporting portion;

affixing a second shoe to the lower, second-side corner, said second shoe having a second strut-supporting portion;

placing a length altering strut between the first and second strut-supporting portions;

altering the length of said length-altering strut; and

measuring at least one dimension of said rectangular area after the length of the length-altering strut has been altered.

The examiner's Answer cites the following prior art:

Deuar	5,051,919	Sep. 24, 1991
Westermo et al. (Westermo)	5,086,651	Feb. 11, 1992

OPINION

Claims 1-13 stand rejected under 35 U.S.C. § 103 as unpatentable over Deuar in view of Westermo.

According to the examiner, it would have been obvious "to provide the pole tester of Deuar with the measuring arrangement of Westermo et al, in order to measure all of the possible deflection points in the wall specimen." However, the only wall specimen in Deuar is a retaining wall. There is no evidence that such a retaining wall would have the recited corners. Since Deuar

has not been shown to have the recited corners, we cannot agree with the examiner that it would have been obvious to use Westermo's corner-to-corner measuring arrangement on Deuar's retaining wall. Therefore, the examiner's rejection of Claims 1-13 will not be sustained.

NEW GROUND OF REJECTION

We hereby enter the following new ground of rejection pursuant to 37 CFR § 1.196(b). Claims 1, 2, and 6 are hereby rejected under 35 U.S.C. § 102 as anticipated by Westermo.

Westermo's Figure 21 discloses affixing a first shoe 427 in first corner 426, affixing a second shoe 425 in second corner 424, and placing a length altering element 422 between the first and second shoes. The length altering element 422 may be a compressive rod (strut). Column 17, lines 32-38. We note that appellant discloses a "force applying length altering strut." Specification at 2, lines 23-25. The recited length altering strut is not limited to a "force applying" length altering strut.

Westermo discloses that the length of length altering strut 422 is altered by the force of seismic activity, for example. Column 1, lines 18-31. This satisfies the recited step of altering the length of the length altering strut. Claims undergoing examination are given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (in banc). The broadest reasonable interpretation of the "altering" step includes

altering by the force of seismic activity. This is consistent with appellant's specification which states that the inventive testing method "is analogous to the force of seismic activity."

Specification at 10, lines 9-12.

Westermo measures at least one dimension of the rectangular area. Column 14, lines 1-30.

Claim 2 requires that the length of the length altering strut is lengthened. Westermo discloses that the length may either be shortened (compressed) or lengthened (tensed). Column 11, lines 46-57; column 15, lines 21-31; and column 17, lines 32-38.

Claims 6 requires measuring along the length altering strut. This is disclosed by Westermo. Column 14, lines 1-30.

CONCLUSION

The examiner's rejection of Claims 1-13 is not sustained. A new ground of rejection is entered against Claims 1, 2, and 6 as anticipated by Westermo.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to

Appeal No. 96-1639
Application 08/269,140

the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED - 37 CFR § 1.196(b)

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
)	
JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
)	INTERFERENCES
)	
JAMES T. CARMICHAEL)	
Administrative Patent Judge)	

Appeal No. 96-1639
Application 08/269,140

EDGAR W. AVERILL, JR.
AVERILL & VARN
8244 PAINTER AVE.
WHITTIER, CA 90602